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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,916	03/30/2004	Yasuyuki Numajiri	00684.003621.	3181

5514 7590 05/21/2008
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EXAMINER

BOWERS, NATHAN ANDREW

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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05/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/811,916	Applicant(s) NUMAJIRI ET AL.	
	Examiner NATHAN A. BOWERS	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 March 2008 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1) Claims 1-3 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffin (US 20050272169).

With respect to claim 1, Griffin discloses a biochemical cartridge comprising a reaction portion (Figure 1:14) that includes a plurality of chambers (Figure 1:16, 18, 17, 20) and a plurality of channels (Figure 1:15). A solution storage portion (Figure 1:12) is isolated and separated above the reaction portion. A penetrable portioning member (Figure 1:13) is disposed between the solution storage portion and the reaction portion so as to move the solution from the

solution storage portion to the chamber of the reaction portion. This is disclosed in paragraphs [0009]-[0012] and [0084]-[0094].

With respect to claims 2 and 3, Griffin discloses the apparatus in claim 1 wherein the partition member is penetrable by pushing with a valve stem. In paragraphs [0096] and [0097], Griffin teaches that a piercing pin (Figure 3:145) and a plunger (Figure 1:130) are used to penetrate the partition member. The piercing pin is fully capable of acting as a valve stem that seals the hole through the partition member by being pushed to a second-stage.

With respect to claim 11, Griffin discloses a biochemical treatment apparatus comprising an accommodation unit in which a biochemical reaction cartridge including a reaction portion (Figure 1:14) and a solution storage portion (Figure 1:12) are mounted. The reaction and solution storage portions each have a plurality of chambers that correspond to one another such that reagents from the storage portion are collected in the reaction portion following the activation of a driving means (Figure 3:145). The driving means penetrates a partition member (Figure 1:13) of the biochemical reaction cartridge mounted in the accommodation unit. Various reaction treatment means are provided for causing the rupture of the partition member. The partition member can be broken due to the pumping of excess fluids to the chambers of the solution storage portion, or through the mechanical activation of a plunger (Figure 3:130). This is described in paragraphs [0084]-[0098]. Paragraph [0090] states that a control means in the form of a microprocessor is provided for regulating the motion of the driving means.

With respect to claim 12, Griffin discloses the apparatus in claim 11 wherein the penetration means is provided in the biochemical reaction cartridge. Figures 3-21 clearly show that a piercing pin is provided within the cartridge.

With respect to claim 13, Griffin discloses the apparatus in claim 11 wherein the penetration means is provided to the biochemical treatment apparatus. In paragraph [0014], Griffin states that the penetration means is provided in the form of extra fluid that is pumped to the chambers of the solution storage portion via the reaction treatment means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2) Claims 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US 20050272169).

With respect to claims 4 and 5, Griffin discloses the apparatus set forth in claim 3 as set forth in the 35 U.S.C. 102 rejections above. Griffin additionally teaches in paragraphs [0096] and [0097] that the needles (Figure 3:145) are moved using a pressing rod (Figure 3:130). Griffin does not expressly disclose that multiple pressing rods of differing lengths are used to determine how far the needles are allowed to penetrate into the partition member (Figure 3:113). However, simple changes to the shape and size of a structure are not considered to be patentable distinctions over the prior art. At the time of the invention, it would have been obvious to utilize pressing rods that are of a suitable length. The length of the pressing rods is considered to be a result effective variable that is optimized through routine experimentation. See MPEP 2144.04 and 2144.05.

With respect to claim 8, Griffin discloses the invention as set forth in the rejections above. Additionally, Griffin teaches that solutions contained in a plurality of chambers (Figure 1:22) on the solution storage portion (Figure 1:12) are independently moved through the partition member (Figure 1:13) and collected in corresponding chambers (Figure 1:116) of the reaction portion (Figure 1:14). Each solution is moved via channels (Figure 1:15) to a central reaction area (Figure 1:18) in order to facilitate the detection of analytes. Griffin, however, teaches that

the same partition member is punctured multiple times. Griffin does not indicate that each solution storage portion chamber is associated with a separate partition member.

At the time of the invention, it would have been obvious to divide the comprehensive partition member disclosed Griffin into a plurality of smaller partition members each selectively associated with a specific solution storage chamber. This would have been beneficial because it would have ensured that defects in one partitioning area do not affect the operation of the device in other partitioning areas. The separation of a large structure into a plurality of smaller structures characterized by identical properties is generally not considered to be a patentable improvement over the prior art. See MPEP 2144.04.

3) Claims 6, 7, 9, 10, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US 20050272169) as applied to claims 1, 8 and 11, and further in view of Vann (US 6432719).

Griffin discloses the apparatuses and method set forth in claims 1, 8 and 11 as set forth in the 35 U.S.C. 102 and 103 rejections above. In paragraph [0090], Griffin teaches that the treatment sequence including the order of penetration of the partition member is regulated using a microprocessor controller. Griffin, however, does not indicate that the controller is capable of operating based on information provided by identification codes placed on the cartridge.

Vann discloses a biochemical reaction cartridge comprising a reaction portion formed by a base plate (Figure 1:22) and a frame assembly (Figure 1:46). The frame assembly is divided in such a way to provide a plurality of reaction chambers (Figure 1:32). A solution storage portion

(Figure 1:42) is positioned over the reaction portion in order to move fluids stored within the storage portion to the chambers of the reaction portion using a partition member (Figure 7:278, 280). Specifically, Vann discloses in column 6, line 65 to column 8, line 11, column 10, lines 7-49 and column 11, lines 46-64 that a magnetic pinch valve is used to regulate the flow of fluid to the reaction portion from the storage portion. Operation of the cartridge is regulated by a control computer that receives information regarding the contents of the solution storage containers via identification codes printed on the solution storage containers.

Griffin and Vann are analogous art because they are from the same field of endeavor regarding biochemical reaction cartridges.

At the time of the invention, it would have been obvious to provide the cartridge disclosed by Griffin with an identification code that is reflective of the contents of each of the solution storage portion chambers. As evidenced by Vann, it is known in the art to use bar codes in an automated system to ensure that reagents are added to a reaction chamber in the correct order. The use of identification codes is effective since it allows the user to quickly determine the contents of a specific storage container and proceed according to the predetermined treatment sequence.

Response to Arguments

Applicant's arguments filed 26 February 2008 with respect to the 35 U.S.C. 102 and 103 rejections involving Griffin have been fully considered but they are not persuasive.

Applicant's principle arguments are

(a) Griffin fails to disclose a cartridge in which a solution storage portion is separated from the reaction portion when the cartridge is not in use. Griffin appears to disclose a unitary multi-layered structure in which the upper layer 12 is combined with the lower layer 11 even when the device is not in use.

In response to Applicant's arguments, please consider the following comments.

Figures 1 and 3 of Griffin show that the solution storage portion 12 is formed as a *separate* structure from the reaction portion 11. The storage portion is separated from the reaction portion when the cartridge is not in use because each portion is formed as an autonomous unit. Simply put, the storage portion is separated from the reaction portion at all times. Even though the storage portion and the reaction portion are indirectly coupled together, they are certainly *separated* into two different independent units.

Another interpretation would be to say that they are separated from each other because a frangible membrane 13 is formed between the two stacked portions. Paragraph [0034] further states that the reaction portion is formed separately from the storage portion. Paragraph [0051] indicates that the storage portion kept at a different location (when not in use), and is only brought into communication with the reaction portion at a more convenient time.

Perhaps language indicating that "the solution storage portion and the reaction portion are reversibly coupled together" would – if enabled by Applicant's specification – be a clearer and more effective way to differentiate from the Griffin reference (although some luer fittings utilized by Griffin are known to be reversible – see paragraph [0044]).

Conclusion

This is a non-final rejection.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A. Bowers whose telephone number is (571) 272-8613. The examiner can normally be reached on Monday-Friday 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Beisner/
Primary Examiner, Art Unit 1797

/Nathan A Bowers/
Examiner, Art Unit 1797